

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Mark G. Erlander, et al.

Application No.: 10/773,761

Filed: February 6, 2004

For: PREDICTING BREAST CANCER
TREATMENT OUTCOME

Customer No.: 70680

Confirmation No. 5596

Examiner: Qian, C.X.

Technology Center/Art Unit: 1636

REPLY TO RESTRICTION
REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Restriction Requirement, mailed December 17, 2007, which set January 17, 2008 as the initial deadline for reply. A Petition for a five-month extension of time until June 17, 2008 is enclosed herewith, so this Reply is believed to be timely filed.

As an initial matter, Applicants point out that prior to the instant Requirement of December 17, 1007, pending claims 6-31, 32-38, 42, and 52-66 were searched and examined as indicated by the Office Action mailed June 20, 2007. In fact, only claims 49 and 50 were withdrawn from consideration.

But now, claims 6-31, 32-38, 42, 49, 50 and 52-66 are under Restriction as allegedly encompassing three distinct inventions:

Group I, claims 6-31, 52-55, 58, and 61-66;

Group II, claims 32-38, 42, 49, 57, 59, and 60; and

Group III, claims 32-38, 42, 50, 56, 59, and 60.

Applicants strongly traverse.

As indicated in the instant Restriction Requirement, there must be a “serious burden of search” present to support a requirement for restriction. But it is not possible to meet this requirement because claims 6-31, 32-38, 42, and 52-66 have already been searched and examined during prosecution of the instant application as explained above. Applicants respectfully point out that there can be no “serious burden of search” present where the claims have already been searched and examined as shown by the Office’s previous communication.

There is additional evidence of insufficient basis to support a requirement for restriction. For example, all three alleged Groups are similarly classified in class 435, subclass 6. So by the Office’s own classification system, the three Groups are within the identical *subclass* of technology.

Moreover, and contrary to statements made in the instant Restriction, alleged Groups II and III are clearly related to alleged Group I as individual subcombinations (each of Groups II and III) to a combination (Group I). This is clearly demonstrated by a simple consideration of the subject matter of alleged Groups II and III, which are used in combination within alleged Group I.

In light of this combination/subcombination relationship, the instant Requirement must satisfy the well established standards for cases of a combination/subcombination as set forth at MPEP 806.05(c). Those standards include the need to demonstrate that “the combination as claimed [alleged Group I] does not require the particulars of the subcombination[s] as claimed [each of alleged Groups II and III] for patentability”.

But these standards for a subcombination/combination situation have not been applied in the instant case, and so no proper basis for requiring an election among the alleged Groups has been presented.

In light of the above, Applicants respectfully submit that **no** proper Restriction between the alleged Groups is possible, and the instant Requirement should be withdrawn so that claims 6-31, 32-38, 42, and 52-66 continue to be examined together.

With respect to previously withdrawn claims 49 and 50, the instant Restriction Requirement appears to vacate the previous Restriction Requirement which led to their withdrawal. If so, it would appear that claims 49 and 50 should be examined with claims 6-31, 32-38, 42, and 52-66 for the reasons provided above. But in light of past prosecution in this application and an interest of advancing prosecution, Applicants are prepared to continue with their original election of claims 6-31, 32-38, 42, and 52-66, with claims 49 and 50 withdrawn from consideration.

In the event the instant Requirement is maintained despite the above, Applicants elect Group I, claims 6-31, 52-55, 58, and 61-66, with combination of sequences encompassed by claim 15 with traverse for the reasons provided above.

Dated: June 17, 2008

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